

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Jared J. Jackson )  
 )  
Application No.: 09/812,872 )  
Confirmation No.: 1256 )  
Group Art Unit: 2155 )  
Filed: March 19, 2001 )  
Examiner: ASAD M NAWAZ )  
For: SYSTEM AND METHOD FOR )  
ADAPTIVE FORMATTING OF IMAGE )  
INFORMATION FOR EFFICIENT )  
DELIVERY AND PRESENTATION )  
\_\_\_\_\_ )

Board of Patent Appeals and Interferences  
Commissioner for Patents  
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**APPELLANT'S REPLY BRIEF**

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Sir:

In response to the Examiner's Answer dated June 30, 3008, the two month due date for response to which is September 2, 2008 (the first business day after August 30, 2008), Appellant hereby respectfully submits his reply brief in support of his appeal to the Board of Patent Appeals and Interferences of the Examiner's final rejection of claims 1-22 of the above-referenced application.

## **RESPONSE TO EXAMINER'S ARGUMENTS**

### **THE INDEPENDENT CLAIMS ARE PATENTABLE OVER LEE IN VIEW OF HOLTZ**

The Examiner has taken the position that independent claims 1-3, 7, 9, and 11 are unpatentable over Lee et al. U.S. Patent No. 6,779,040 in view of Holtz et al. U.S. Pre-Grant Publication No. 2002/0053078. In response, the Appellant respectfully traverses this rejection, and submits that Lee and Holtz individually and/or in combination with each other do not teach or suggest all the elements and limitations of the claimed invention. Consequently, the claims on file are not taught or suggest by Lee and/or Holtz, and the allowance of these claims is earnestly solicited.

The Examiner states on pages 9 to 10 of the Examiner's Answer that the Appellant argued "Argument A: Lee is silent regarding session information and the image delivery and image presentation parameters are not separate (see brief page 14)". The Examiner goes on to state:

In response to A), the claim language states the request for delivery of image information is separate from the session information which comprises the image delivery parameter and the image presentation parameter. Lee teaches "a user may specify a set of user computer capabilities and user preferences while requesting a particular JPEG image from the server computer" (see col 4, lines 13-18). Therefore along with a request for the JPEG image, session information comprising a user computer capability and user preferences is also transmitted (thus being separate). The capability and user preferences are used to determine the size, resolution, compression, format, etc of the requested JPEG image (see fig 1, col 4, lines 29-59). Therefore, Lee in view of Holtz still meet the scope of the limitations as claimed.

The Appellant respectfully points out that, contrary to the Examiner's conclusion in the Examiner's Answer, Appellant never made such an argument that "the image delivery and image presentation parameters are not separate" on page 14 of the Appellant's Amended Appeal Brief. However, the Appellant did argue extensively on pages 17-19 of the Appellant's Amended Appeal Brief that the Examiner's interpretation of the claims reciting

that the image delivery and image presentation parameters are separate from the session information was clear error because a plain reading of the claim language, by the teachings in the specification, and by Applicant's arguments in the responses to the Office Actions clearly shows that the image delivery and image presentation parameters are comprised within the session information.

Therefore, it is unclear as to what argument the Examiner is responding to. Additionally, in the Final Office Action, on page 4, the Examiner states that:

Lee et al. **does not** explicitly indicate the request including a session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of image information and the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.  
**(Emphasis added.)**

Now, in the Examiner's Answer, on pages 9 to 10, the Examiner states that:

Lee teaches "a user may specify a set of user computer capabilities and user preferences while requesting a particular JPEG image from the server computer" (see col 4, lines 13-18). Therefore along with a request for the JPEG image, **session information comprising a user computer capability and user preferences is also transmitted (thus being separate)**. The capability and user preferences are used to determine the size, resolution, compression, format, etc of the requested JPEG image (see fig 1, col 4, lines 29-59).  
**(Emphasis added.)**

In other words, the Examiner now seems to be inferring that Lee **does** teach "the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information". If the Examiner is in fact asserting this then this contradicts the Examiner's acknowledgement in the Final Office Action dated May 4, 2007, that Lee **does not** explicitly teach these claim elements.

Also, with a citation to only a first part of the paragraph, at col. 4, lines 13-18, and with Examiner's statement of "[T]herefore along with a request for the JPEG image, session information comprising a user computer capability and user preferences is also transmitted (thus being separate)", the Examiner seems to be mischaracterizing Lee. For example, the entire paragraph (col. 4, lines 11-28), including the portion at column 4, lines 13-18, of Lee, is provided below:

One embodiment of the present invention relates to the serving of JPEG images stored on server computers to user computers via the Internet. Each user may register a set of user computer capabilities and user preferences with the server computer and, in addition, a user may specify a set of user computer capabilities and user preferences while requesting a particular JPEG image from the server computer. Upon receiving a request for a JPEG image file from a user computer, the server computer retrieves a compressed or partially compressed version of the JPEG image file and compresses it according to the specified capabilities of the requesting user's computer and according to any specified user preferences. This compression according to capabilities and preferences is carried out in a computationally efficient and memory-efficient manner. The JPEG image file compressed according to the capabilities of the user's computer and the user's preferences, is then transferred over the Internet to the user's computer.  
**(Emphasis added).**

As can be seen, the bold underlined portion indicates that the user specifies a set of user computer capabilities and user preferences while requesting a particular JPEG image, and when the JPEG request is received by the server it causes the server to compress the file according to specified capabilities and user preferences. Stated differently, the JPEG request comprises the user specified capabilities and user preferences, and not session information as asserted by the Examiner. This understanding is also reinforced by the teachings of Lee at col. 12, lines 51-56, which will be further discussed below. In fact, the above indicated paragraphs of Lee teach away from session information containing image delivery parameters and image presentation parameters.

However, regardless of the ambiguity of the Examiner's response and the apparently contradicting remarks made by the Examiner, Lee still does not teach or suggest "the session

information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information".

For example, Lee at col. 12, lines 51-56 teaches:

In step 1402, the routine "provide\_image" determines whether the request for an image from a client computer includes an indication of client computer capabilities and user preference parameters and whether the request for the image includes a rule for applying the parameters.  
**(Emphasis added).**

In other words, Lee teaches that the actual image file request includes computer capabilities and user preference parameters. This is further supported by col. 4, lines 11-28 of Lee, which has already been discussed above. The presently claimed invention, on the other hand, recites that (emphasis added):

receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information

In other words, a request in the presently claimed invention includes both (1) a request for delivery of image information to a networked device and (2) session information, which is separate from the delivery request, pertaining to a current communication session between the networked device and a server, where the session information comprises the image delivery parameter and the image presentation parameter. Lee does not teach or suggest this. Lee, at best, only teaches that the image delivery request includes the computer capabilities and user preference parameters. Accordingly, the presently claimed invention distinguishes over Lee for at least these reasons.

Furthermore, Holtz also does not teach or suggest:

receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.

The Holtz reference is only directed towards a multimedia production and distribution system where a client can select various options to customize the transmission from the server to the client. See Holtz Abstract. Holtz is not concerned with current device or network conditions and/or capabilities, as is the present invention. Holtz does not send “parameters,” but instead sends requests for file formats (e.g. WMV format, MPEG format, etc.). If a user using the Holtz invention made a request for media in a particular format and subsequently network conditions or connection type changed the Holtz invention would not respond to accommodate those changes, as would the present invention. In other words, Holtz is not concerned with parameters. Holtz is also silent regarding session information.

Furthermore, Holtz is able to request transmission types, such as downloaded, streamed, or saved to the client. See Holtz, paragraph [0026]. However, these requests are not made by transmitting session information, image delivery parameters, or image presentation parameters, but are instead made by specifically requesting a particular transmission method.

A reading of Holtz reveals that Holtz is not concerned with receiving session information pertaining to a current communication session between the networked device and a server that is separate from an image information delivery **request**, where the session information includes image delivery parameters and the image presentation parameters. For example, Holtz explicitly teaches that “media streams [are] formatted to support multimedia applications available from “RealNetworks, Inc. (Seattle, Wash.), Microsoft Corporation (Redmond, Wash.), and Apple Computer, Inc. (Cupertino, Calif.), or like applications as would be apparent to one skilled in the relevant art(s). In addition to the aforementioned proprietary

formats, the media stream formats can include, but are not limited to, MPEG-2 and MPEG-4 non-proprietary formats.” See Holtz at paragraph [0062]. Also, Holtz teaches that a viewer on the media client allows a user to build a show. Once a user builds the show the media client receives an ASX metafile for playing multiple WMV files.

As can be seen, the content in Holtz is already pre-formatted based on a pre-selected application. Stated differently, the content on the enhanced media server of Holtz is already formatted prior to receiving a request from a client device. **Customization as referred to by Holtz merely allows a user to select the content (e.g. video segments) that is to be sent to his/her device.** See Holtz at paragraphs [0085-0086] and [0203-0211]. Nowhere does Holtz teach or suggest “receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information”.

The Examiner on pages 10-11 of the Examiner’s Answer states that the Appellant argued “Argument B: There is no motivation to combine Lee and Holtz (see brief page 15). The Examiner goes on to state:

In response to applicant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is generally known in the art that a session is created between a client and a server during a mutual sharing of information/messages/requests. It is here that Holtz was utilized to show that sessions are common in the field and essential for security.

Furthermore, Lee is directed towards the requesting and reception of media

data. Likewise, Holtz is also from a similar field of endeavor. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

As can be seen, the Examiner's Answer states that Holtz was used to "show that sessions are common in the field and essential for security". However, the Examiner in the Final Office Action dated May 4, 2007, on page 4, did not merely use Holtz to "show that sessions are common in the field and essential for security", but used Holtz to expressly teach what was lacking in the teachings of Lee, that the combination teaches:

a session information pertaining to the current communication session between the networked device and a server, the session information being separate from the request for delivery of image information and the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information (refer to abstract).

As Appellant has already argued above on page 6 of this Reply Brief, Holtz is not concerned with parameters, and further Holtz is also silent regarding session information. Arguendo, if one of ordinary skill in the art would be motivated to combine the teachings of Lee and Holtz, in view that Holts is not concerned with parameters and silent regarding session information, such combination of Lee and Holtz would still not teach or suggest to one of ordinary skill in the art the presently claimed features:

receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information.

Additionally, a combination of Lee and Holtz, to modify Lee with Holtz to teach or suggest the presently claimed invention, would not be suggested to one of ordinary skill in the art because it would destroy the intent, purpose, and/or function of the combination. The



Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such proposed modification is not proper and the prima facie case of obviousness cannot be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Here, the intent of Lee is to compress/format files after a request for the file is received. The intent of Holtz is to have content in a pre-formatted form based on a pre-selected application. Stated differently, the content on the enhanced media server of Holtz is already formatted prior to receiving a request from a client device. Thus, the combination of Holtz with Lee clearly destroys the intent of Lee, thereby rendering this combination improper.

Furthermore, the Examiner's stated motivation and reasoning to combine Lee and Holtz as given in the Final Office Action dated May 4, 2007, of

“[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings Holtz into those of Lee in order to make the system more secure. Keeping information such as session information allows for the parties involved to communicate (sic) in a longer session that has been authenticated without the need to repeatedly input repetitive information”

is not relevant to the subject matter of claim 1 and to overcoming the deficiency of Lee for not teaching at least that “the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information”. The Examiner has not provided a proper reason for the combination of Lee and Holtz that would be relevant to the subject matter of claim 1 and to overcoming the deficiency of Lee. Therefore such proposed modification is not proper and the prima facie case of obviousness cannot be properly made.

Even further, the teachings of Lee and Holtz are silent regarding session information and delivery of parameters in the session information. On the other hand, the present claims are specifically directed to session information and delivery of parameters contained in the

session information. This claimed feature is lacking in both references cited by the Examiner.

Lee is directed towards on-demand data compression of data files for transfer from a server computer to a client computer. A user can submit two different types of requests to a server: 1) a request for an image; and 2) a request to register a set of client computer capabilities and user preferences to be used for future image requests. Importantly, **the preferences and capabilities are known only after a user registers them**. “An example of an indicated parameter might, for example, be a parameter indicating the bandwidth of the client computer's interconnection with the Internet”. The server computer then compresses the requested data file according to the capabilities of the user's computer and user preferences. The information conveyed in Lee is always within a **request to register client computer capabilities and user preference parameters**. **Lee is silent regarding session information comprising image delivery parameter and the image presentation parameter associated with the networked device.**

Holtz is directed towards a multimedia production and distribution system where a client can select multiple video segments from a content sever. The content residing at the content server is already pre-formatted based on a pre-selected application. Stated differently, the content on the enhanced media server of Holtz is already formatted prior to receiving a request from a client device. Customization as referred to by Holtz merely allows a user to select the content such as video segments that are to be sent to his/her device. **Holtz is silent regarding session information comprising image delivery parameter and the image presentation parameter associated with the networked device.**

As can be seen, Lee teaches adjusting the size of data files sent to a client computer **based only on parameters of the client device and client preferences** that are **sent** to the Lee system **by the client as part of a request**. Holtz teaches a system where a client can select multiple video segments from a content sever where they are pre-formatted for particular

applications such as Windows Media Player. The content server then transmits these video segments to the user.

Neither Lee, Holtz, nor any combination thereof, teach or suggest “receiving a request that includes a request for delivery of image information to a networked device and session information pertaining to a current communication session between the networked device and a server, the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information”. Lee, at best, teaches parameters within a **request to register client computer capabilities and user preference parameters**. These parameters such as bandwidth capabilities are used to select a compression type. Holtz teaches that a user sends content selection information. Clearly, the presently claimed “the session information being separate from the request for delivery of image information... the image delivery parameter and the image presentation parameter associated with the networked device being contained in the session information” is **not** rendered obvious from the irrelevant teachings of Lee and Holtz.

As discussed above, the independent claims are patentable over the Lee and/or Holtz references. Since dependent claims contain all the limitations of the independent claims, claims 4-6, 8, 10, 12, and 14-22 are patentable over the Lee and/or Holtz references as well.

## **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application and all of the pending claims are in condition for allowance. Reversal of the final rejection of Claims 1-22 is respectfully requested.

Respectfully submitted,

Dated: August 29, 2008

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